

**PATENT EXAMINER  
REISSUE APPLICATION CHECKLIST**

4/6/99

Examiner:

Luz Alejandro

Art Unit :

1763

Reissue Appl. No.:

10, 786,914

**THIS CHECKLIST IS PROVIDED AS AN AID TO THE REISSUE EXAMINATION PROCESS. IT SHOULD BE USED THROUGHOUT PROSECUTION AND MUST BE REMOVED FROM THE FILE AT THE TIME OF ALLOWANCE AFTER APPROVAL BY THE SPRE.**

All reissue applications are to be treated as "SPECIAL" throughout the prosecution (MPEP § 1442). This means that any reissue application appearing on an examiner's docket should be taken up for action as the next new or amended case, even before other special applications.

Prior to beginning examination of a reissue application, the examiner should obtain and review the original patent file (MPEP § 1440). Examination of the reissue application is frequently directly linked to the prosecution history of the original application.

The Technology Center SPRE will provide the examiner with a copy of the examiner checklist and any initial guidance on reissue practice at the time the application is docketed and the PALM flag is set.

**Examiner:** Complete items 1-18 prior to completing a first action. Then, take the reissue application (and patented file, if available) to the SPRE/Paralegal for review, before mailing the action.

\_\_\_\_\_(SPRE initials) Review before first action.

Complete items 19-20 when preparing the reissue application for allowance. SPRE must initial the file wrapper after review for allowance.

**A "Reissue Guide" containing a further explanation of each of the items on the checklist can be obtained in paper form or electronically by e-mail from the Technology Center SPRE or Paralegal.**

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Indicate that each of the applicable items set forth below has been thoroughly reviewed with respect to the above-identified reissue application by answering YES, NO, or N/A to the following questions. The examiner should be able to answer "YES" to most of the questions. A "NO" answer may require some immediate action at that point or reference to the "Reissue Guide" for further explanation. See TC SPRE for further assistance, if needed.

- Yes 1. Has the original patent file wrapper been obtained and reviewed? *If NO, see "Reissue Guide" for further assistance.*
- Yes 2. Is the (original) patent still in force, i.e., has not expired due to the conclusion of its term or due to the non-payment of the maintenance fees? *A reissue application must actually issue as a reissue patent before expiration of the patent. Accordingly, always make sure the patent will not expire during prosecution of the reissue application. See "Reissue Guide" for methods of checking patent term.*
- Yes 3. Has notice of the filing of the reissue application been published in the Official Gazette (O.G.)? *If NO, STOP action and have your TC Paralegal forward the application to OIPE to effect publication.*
- Yes 4. Is the current date more than two months after the O.G. publication date? *If NO, wait until the two-month period has expired before preparing and issuing Office action.*
- Yes 5. Has the file been reviewed for the presence of any protests under 37 CFR 1.291(a)? *Protests may be filed during the two-month period following the O.G. notice, or anytime thereafter, and should be considered in the next Office action, if in the file. See "Reissue Guide" for instructions on handling protests.*
- NO 6. Is the reissue application a division or a continuation of another pending reissue application? *See In re Graff, 42 USPQ2d 1471. If YES, special handling as per "Reissue Guide" is required.*
- NO 7. Is the patent or the reissue application involved in litigation? *Information may be found in file or requested from STIC. If YES, shortened reply periods may have to be set by the Examiner, or prosecution may have to be suspended. See "Reissue Guide." If NO, proceed with examination.*
- Yes 8. If the reissue application has been assigned, does it include the written consent to the filing by all of the assignees (37 CFR 1.172(a))? *See MPEP § 1410.01. If NO, and a petition for a waiver of this requirement has been granted, the assent may be deferred until the case is otherwise allowable.*
- Yes 9. Have all documents (in applications filed on or after September 24, 1992) signed by, or on behalf of, the assignee(s) been checked and found to comply with the provisions of 37

**CFR § 3.73(b)?** This includes "consent" in No. 8, above. If **NO**, the statement under § 3.73(b) must be required before allowance.

Yes 10.

Were any changes made to the patent by a Certificate of Correction dated prior to the filing of the reissue? If **YES**, check to see if the changes were properly entered as though part of the original patent, i.e., no brackets or underlining. \*\*

Yes 11.

Has the application been reviewed for the presence of any errors, including any not specifically identified, which are not correctable by reissue? Reissue doesn't cure all patent ills. See "Reissue Guide" for listing of some errors which cannot be corrected by reissue.

Yes 12.

Are any claims broader in scope (in **ANY** respect) than the original patent claims? If **YES**, note 35 USC 251, 3rd and 4th paragraphs. If **NO**, proceed to item 14.

NO 13.

Does the broadening (from Item 12) attempt to "recapture" any claimed subject matter which was deliberately added, or argued, to overcome a rejection in the original application? See "Reissue Guide" for explanation of "recapture doctrine." Subject matter deliberately surrendered may not be recaptured (reclaimed) in a reissue application.

NO 14.

Has: (1) the original patent been surrendered **OR** (2) an affidavit/declaration averring that the original patent is lost or misplaced been filed? If **NO**, the application cannot be allowed until either (1) or (2) is obtained.

NO 15.

Does the reissue application seek to provoke an interference with another patent? If **NO**, proceed to Item 17. If **YES**, see "Reissue Guide."

\_\_\_ 16.

Do the issues of interference estoppel and the "lost count" doctrine apply? Applies to losing party of an interference. See "Reissue Guide."

NO 17.

Is there a request to transfer the drawings from the original patented file to the reissue application? If **YES**, be sure there are no amendments or additions to the original figures. Transfer should be made by the TC only if the drawings submitted in the reissue application are not approved by the Office draftsman.

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- NO 8. Does the reissue oath or declaration comply with all of the requirements of 37 CFR § 1.63 and 37 CFR § 1.175? See list of requirements in "Reissue Guide." If NO, reject under 35 U.S.C. 251 (citing relevant portion of 37 CFR 1.63 or 1.175).

THE FOLLOWING QUESTIONS SHOULD BE COMPLETED WHEN PREPARING THE APPLICATION FOR ALLOWANCE:

- \_\_\_ 19. Have all amendments to the specification, drawings and claims been reviewed for compliance with 37 CFR § 1.121(b)? See amendment practice described in "Reissue Guide." If NO, amendment in accordance with § 1.211(b) will be required.
- \_\_\_ 20. The following items should be verified at the time of Allowance:
- \_\_\_ a. Original patent claims have not been renumbered.
  - \_\_\_ b. Final numbering of claims added by reissue must follow the number of the highest numbered patent claim.
  - \_\_\_ c. The claim selected for printing is one which was added or amended during reissue - never a canceled claim.
  - \_\_\_ d. On the inside left flap of the file-wrapper, the final claim numbering must be filled in properly. A canceled patented claim retains its original number although not considered in the total number of claims allowed. Therefore, on the face of the file-wrapper, the number in the box designated "Total Claims" under "CLAIMS ALLOWED" may be less than the highest number of the last allowed claim.
  - \_\_\_ e. The original patent number must be placed on the Issue Classification Slip in the block below the applicant's name.
  - \_\_\_ f. Any Examiner's Amendment which makes changes to the patent which are substantive in nature may necessitate a supplemental reissue oath/declaration from applicant.
  - \_\_\_ g. Classification and cross referencing on the Blue Slip should include at least those classes and subclasses designated on the original patent. If a reclassification prevents use of the same class/subclasses, the new class/subclasses should be used. Call Patent Index (305-5227) to ascertain the new class/subclasses.
  - \_\_\_ h. Terminal Disclaimer (TD) information has been placed on the file wrapper face for TDs filed either in the original patent or in the reissue application.
  - \_\_\_ i. The references cited in the original patent have been cited in the reissue application on a Form PTO-892 or PTO-1449.

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Each reissue application, together with the original patented file must be submitted to the Group SPRE for review prior to counting and issue. The box provided for "FINAL SPRE REVIEW" on the gold and white reissue file wrappers must be initialed by the Group SPRE.

This checklist must be removed from the file by the SPRE at the time of final review.

All reissue applications are screened by the Special Program Law Office (SPLO) after allowance.

Examiner: \_\_\_\_\_

Date: \_\_\_\_\_

EXR\_CHK.WPD